



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/059,278 | 01/31/2002 | Larry E. Mashburn | T2317-907720 | 5374 |

181 7590 09/08/2004
MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

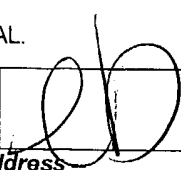
JUSKA, CHERYL ANN

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|---|
| Office Action Summary | Application No. 10/059,278 | Applicant(s) MASHBURN ET AL. | |
| | Examiner Cheryl Juska | Art Unit 1771 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed June 16, 2004, has been entered. The specification and claims 5, 8, 13, 14, 23, 26, and 33 have been amended as requested. The pending claims are 1-35.

2. Said amendment is sufficient to withdraw the claim objection set forth in section 1 of the last Office Action. Additionally, the provisional double patenting rejections set forth in sections 4-6 of the last Office Action are hereby withdrawn due to cancellation of the claims at issue in copending application 10/07,439.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-35 of this application. Specifically, provisional application 60/275,631 does not provide support for the independent claim limitation that the multi-functional alcohol is "present in a ratio to said vegetable oil such that there are at least 0.7 moles of OH groups per mole of bulk vegetable oil." Additionally, there are numerous dependent claim limitations that are not supported (e.g., specific compositional components and the amounts thereof). Thus, applicant's claim for domestic priority under 119(e) is not granted and the effective filing date of claims 1-35 is January 31, 2002.

Double Patenting

Art Unit: 1771

4. Claim 12 stands objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4, as set forth in section 2 of the last Office Action. Applicant traverses on the grounds that the two claims employ different transitional phrases. However, it is argued that the transitional phrase of "is" recited in claim 4 is considered open language equivalent to the transitional phrase "comprising" recited in claim 12. If applicant intends to recite closed language in claim 4, it is suggested the claim be amended to recited "consists of."

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Dependent claims 13-25 and 30-35 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 and 28-33, respectively, of copending Application No. 10/097439. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to select the claimed multifunctional alcohol as the cross-linking agent and to add a catalyst since said cross-linking alcohols and catalysts are readily known in the art of polyurethanes.

This is a provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-16, 18, 19, 22, 26-29, and 32 stand rejected under 35 USC 102(e) as being anticipated by, or in the alternative under 35 USC 103(a) as being unpatentable over US 2002/0090488 issued to Kurth et al. as set forth in section 11 of the last Office Action.

Claim Rejections - 35 USC § 103

9. Claim 17 stands rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference.

10. Claims 20, 21, 24, 25, 30, 31, 34, and 35 stand rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 6,060,145 issued to Smith et al.

11. Claims 23 and 33 stand rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 2003/0114062 issued to Scott et al.

Response to Arguments

12. Applicant's arguments filed with the amendment of June 16, 2004, have been fully considered but they are not persuasive.

Specifically, applicant traverses the rejections based upon the cited Kurth '488 primary reference by asserting the present application has an effective filing date of March 15, 2001 (i.e., filing date of US Provisional Application 60/275,631), which precedes the effective filing date of

Art Unit: 1771

said Kurth reference (i.e., October 10, 2001). This argument is unpersuasive for two reasons.

First, as noted above, the domestic priority claim has not been granted since said provisional application does not provide adequate support under 112, 1st for the presently claimed invention.

Secondly, the effective filing date of the Kurth reference is not October 10, 2001, but rather October 10, 2000. Although Kurth '488 is in fact a continuation-in-part 09/646,356, the reference also claims and has been granted domestic priority to provisional application 60/239,161 having a filing date of October 10, 2000. Therefore, applicant's argument is unpersuasive and the above rejections stand.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

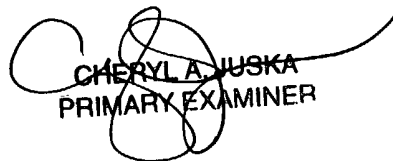
14. Any inquiry concerning this communication or earlier communications from the

Art Unit: 1771

examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
September 1, 2004